

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q77644

Hiroaki NAKAMURA, et al.

Appln. No.: 10/669,653

Group Art Unit: 2624

Confirmation No.: 5576

Examiner: Jeffrey S. Smith

Filed: September 25, 2003

For: IMAGE RECORDING APPARATUS

**SUBMISSION OF APPEAL BRIEF**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

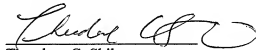
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$540.00 and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Theodore C. Shih

Registration No. 60,645

SUGHRUE MION, PLLC

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: January 22, 2009

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**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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**I. REAL PARTY IN INTEREST**

The real party in interest is FUJIFILM Corporation, by virtue of an assignment executed by Hiroaki NAKAMURA and Toshihiko KAKU (Appellants, hereafter), on September 18, 2003, and recorded by the Assignment branch of the U.S. Patent and Trademark Office on September 25, 2003 (at Reel 014541, Frame 0825). The assignee had undergone a name change, as recorded on February 15, 2007 at Reel 018904, Frame 0001.

**II. RELATED APPEALS AND INTERFERENCES**

To the knowledge and belief of Appellants, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

**III. STATUS OF CLAIMS**

The Application was originally filed with claims 1-4, and claims 1-13 are the currently pending claims.

Claims 6, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph. Claims 1-3 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by White et al. (U.S. 7,035,462; hereinafter “White”). Claim 4 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White. Claims 5-8 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White in view of Shiota et al. (U.S. 6,345,998; hereinafter “Shiota”). Claims 9-13 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White.

The rejections of claims 1-13 are being appealed.

**IV. STATUS OF AMENDMENTS**

The Response filed July 21, 2008 did not include any amendments, and no outstanding amendments to the claims are currently pending. Thus the claims stand as presented prior to the Final Office Action dated February 22, 2008.

The arguments of the July 21, 2008 Response are believed to have been entered.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The instant application is directed toward an image recording apparatus for recording an image corrected through an application of a predetermined correcting process to an original image.

According to claim 1, disclosed is an image recording apparatus comprising:  
an image data input section<sup>1</sup> that enters image data<sup>2</sup> representative of an original image<sup>3</sup>;  
an image correcting section<sup>4</sup> that applies a predetermined correcting processing to the original image represented by the image data entered through the image data input section to create a corrected image<sup>5</sup>; and  
an image recording section<sup>6</sup> that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media<sup>7</sup> for recording an image in a form of either one of an image recording on a visual basis and a recording of image data, and records either one of a set of image and information capable of reproducing the original image

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<sup>1</sup> See FIG. 3, element 191; and page 14, line 23

<sup>2</sup> See page 14, lines 24-26

<sup>3</sup> See FIG. 2, element 20; and page 10, lines 1-8

<sup>4</sup> See FIG. 3, element 192

<sup>5</sup> See page 14, lines 26 - page 15, line 2

<sup>6</sup> See FIG. 3 and 5, element 193

<sup>7</sup> See FIG. 1, element 200; FIG. 5, element 30; page 20, line 27 - page 21, line 4; and page 21, lines 7-12

and the original image onto a second external media<sup>8</sup> for recording an image in form of either one of an image recording on a visual basis and a recording of image data.

According to claim 4, disclosed is an image recording apparatus according to claim 1, wherein the image data input section<sup>9</sup> enters a photographic image<sup>10</sup>, and

the image recording section<sup>11</sup> records the corrected image into a first photographic print<sup>12</sup>, and records at least either one of the set of image and information and the original image<sup>13</sup> into a second photographic print<sup>14</sup>.

According to claim 5, disclosed is an image recording apparatus according to claim 1, wherein the image correcting section<sup>15</sup> transmits the corrected image and image data together to the image recording section<sup>16</sup>.

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<sup>8</sup> See FIG. 3 and 5, element 165; page 21, lines 4-7 and lines 12-14

<sup>2</sup> See FIG. 5, element 191; and page 19, lines 10-15

<sup>10</sup> See FIG. 5, and page 19, lines 10-15

<sup>11</sup> See FIG. 5, element 193; and page 20, lines 27 - page 21, line 14

<sup>12</sup> See FIG. 5, element 30; and page 21, line 7-10

<sup>13</sup> See page 21, lines 15-26

<sup>14</sup> See FIG. 5, element 165; and page 21, lines 6-7

<sup>15</sup> See page 20, lines 22-26

<sup>16</sup> See FIG. 5, element 192; and page 19, lines 18-25



According to claim 6, disclosed is an image recording apparatus according to claim 1, wherein the image correcting section<sup>17</sup> transmits the corrected image and image data simultaneously to the image recording section<sup>18</sup>.

Accordingly to claim 7, disclosed is an image recording apparatus according to claim 1, wherein the image recording section<sup>19</sup> records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data<sup>20</sup>.

According to claim 8, disclosed is an image recording apparatus according to claim 1, wherein the image recording section<sup>21</sup> records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data<sup>22</sup>.

According to claim 9, disclosed is an image recording apparatus comprising:  
an image data input section<sup>23</sup> that enters original image data<sup>24</sup> representative of an original image<sup>25</sup>;

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<sup>17</sup> See page 20, lines 22-26

<sup>18</sup> See FIG. 5, element 192; and page 19, lines 18-25

<sup>19</sup> See FIG. 5, element 193

<sup>20</sup> See FIG. 5 and page 20, line 27 - page 21, line 14

<sup>21</sup> See FIG. 5, element 193

<sup>22</sup> See page 21, lines 15-26

<sup>23</sup> See FIG. 3, element 191; and page 14, line 23

an image correcting section<sup>26</sup> that applies a predetermined correcting processing to the original image data to create corrected image data<sup>27</sup>, and transmits the corrected image data and original image data together to the image recording section<sup>28</sup>; and

an image recording means<sup>29</sup> for recording one of: a) a corrected image corresponding to the corrected image data subjected to the correcting processing and b) the corrected image data onto a first external media<sup>30</sup> for recording one of: an image perceived on a visual basis and a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media<sup>31</sup> for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data.

According to claim 10, disclosed is an image recording apparatus according to claim 9,

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<sup>24</sup> See page 14, lines 24-26

<sup>25</sup> See FIG. 2, element 20; and page 10, lines 1-8

<sup>26</sup> See FIG. 3, element 192

<sup>27</sup> See page 14, lines 26 - page 15, line 2

<sup>28</sup> See page 20, lines 22-26

<sup>29</sup> See FIG. 3 and 5, element 193

<sup>30</sup> See FIG. 1, element 200; FIG. 5, element 30; page 20, line 27 - page 21, line 4; and page 21, lines 7-12

<sup>31</sup> See FIG. 3 and 5, element 165; page 21, lines 4-7 and lines 12-14

wherein the image correcting section<sup>32</sup> transmits the corrected image and image data simultaneously to the image recording section<sup>33</sup>.

According to claim 11 disclosed is an image recording apparatus according to claim 9, wherein the image correcting section<sup>34</sup> transmits the corrected image and image data sequentially to the image recording section<sup>35</sup>.

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<sup>32</sup> See page 20, lines 22-26

<sup>33</sup> See FIG. 5, element 192; and page 19, lines 18-25

<sup>34</sup> See page 20, lines 22-26

<sup>35</sup> See FIG. 5, elements 192 and 193

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 6, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph.
2. Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph.
3. Claims 1-3 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by White et al. (U.S. 7,035,462; hereinafter “White”).
4. Claim 4 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White.
5. Claims 5-8 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White in view of Shiota et al. (U.S. 6,345,998; hereinafter “Shiota”).
6. Claims 9-13 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White.

## **VII. ARGUMENT**

For each ground of rejection, the claims do not stand or fall together but are patentable on separate grounds as forth below.

### **1. Claims 6, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph.**

The Examiner alleges that claims 6, 10, and 11 contain new matter which is missing from the application as originally filed.

#### **Claims 6 and 10**

Appellants respectfully submit that the specification is clear in that the corrected image data and image data are transmitted simultaneously to the image recording section. Page 20, lines 22-26 of the specification recites that the corrected image data and photographic image data are transmitted together to the image recording section. Furthermore, FIG. 5 also depicts the simultaneous transmission of the image data and corrected image data from the image correcting section 192 to the image recording section 193. It would be inherent that if the image data and corrected image data were transmitted together then the data transmission would also be simultaneously transferred. Finally, to one of ordinary skill in the art, the term “together” is commonly known to mean “at the same time, or simultaneously<sup>36</sup>”.

Accordingly, Appellants respectfully request that the Examiner withdraw the 35 U.S.C. 112, first paragraph rejection of claims 6 and 10.

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<sup>36</sup> <http://dictionary.reference.com/browse/together>

**Claim 11**

Appellants respectfully submit that the specification is clear in that the corrected image data and image data are transmitted sequentially to the image recording section. Appellants' specification teaches that an operator may designate the first external media and the second external media by using a mouse. (See page 25, lines 1-4). By using a mouse as taught in the specification, a user would not be able to designate both the first external media and second external media at the same time. Thus, by first designating a first media, and then designating a second media, the corrected image would *first* be sent to the first media *and then* the image data would be sent to the second media. Thus, by the operator designating the first external media and then the second external media, it is clear that the specification teaches the sequential data transmission.

Accordingly, Appellants respectfully request that the Examiner withdraw the 35 U.S.C. 112, first paragraph rejection.

**2. Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph.**

The Examiner alleges that in claim 1, the phrase "records either one of a set of image and information capable of reproducing the original image and the original image on a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data", does not "make any sense" to the Examiner.

Appellants respectfully submit that "a set of image and information capable of reproducing the original image" refers to the image recording section 197 transmitting the "corrected image" and "correction information" to the FD 165 as seen in FIG. 6. (See also, page 23, line 17 - page 24, line 5). Furthermore, the claim feature "original image" refers to

“photographic image” that is transmitted from the image recording section 193 to the FD 165 as seen in FIG. 5. And finally, the claim feature “for recording an image in form of either one of an image recording on a visual basis and a recording of image data” refers to either the recording of the image on photographic paper or data storage. (See page 23, lines 11-22). Thus, the claims specify printing or storing uncorrected images to a first medium (print or data); and printing or storing corrected images and correction information to a second medium without being unduly limiting to the claims. The claims describe the features in basic Markush form. Thus the terminology used in the independent claims are sufficiently clear and the claims meet all requirements of 35 U.S.C. § 112 second paragraph.

Claims 2 and 3 are patentable based on their dependency.

Claim 4 recites, “records at least either one of the set of image and information and the original image into a second photographic print”. The examiner asserts that claim 4, similarly to claim 1, is unclear. Appellants respectfully submit that the “set of image and information” refers to the “corrected image” and “correction information” as seen in FIG. 6 and page 23, line 17 - page 24, line 5, where the corrected image may be restored to the original photographic image data by using the correction information. Further, the “original image” refers to the “photographic image data”. (See page 22, lines 4-5).

Accordingly, Appellants respectfully request that the Examiner withdraw the 35 U.S.C. 112, second paragraph rejection.

**3. Claims 1-3 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by White et al. (U.S. 7,035,462; hereinafter “White”).**

**Claim 1**

The Examiner asserts that “the output image from printer 61 of figure 10” and “column 14, the pixel information can be the corrected pixel information and/or the pixel information previous to being corrected and stored in external media such as memory card 28 as shown in block 126 of figure 11” of White as disclosing:

an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in a form of either one of an image recording on a visual basis *and* a recording of image data, and records either one of a set of image and information capable of reproducing the original image and the original image onto a second external media for recording an image in form of either one of an image recording on a visual basis and a recording of image data.

As an initial matter, the rejection is legally incorrect. Printer 61 cited by the Examiner corresponds to a kiosk embodiment of FIG. 10. Memory 28 cited by the Examiner corresponds to a digital camera embodiment of FIG. 1. The different embodiments may not be combined in the absence of a motivation to do so. There is no basis to combine operations of a camera with those of a print kiosk. Federal Circuit case law indicates that the rejection is legally improper. The Examiner may not alter or combine embodiments without a basis to do so. See *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003); and *Net MoneyIN, Inc. v. Verisign, Inc.*, U.S. No. 2007-1565 (Fed. Cir. Oct. 20, 2008), (holding that an Examiner is not permitted to use multiple embodiments of a reference as a basis for anticipating a single claim).

To the extent that the Examiner continues to rely on metadata to provide uncorrected (original) image data, there is no basis to conclude that the storage of the metadata is to a second



external medium. For instance, the media interface 68 is a read device and does not inherently have a record (store) feature. Metadata can also be associated with an internal memory. For example, the controller 67 inherently has an internal memory. Any metadata can be stored there. There is no inherent storage of the cited data to an external medium. The rejection of claim 1 therefore should be withdrawn.

Accordingly, claims 2-4 should be patentable at least by virtue of their dependency from claim 1.

**4. Claim 4 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White.**

**Claim 4**

As argued in Appellants' Amendment dated January 14, 2008, Appellants submit that White fails to disclose:

the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print.

The Examiner asserts:

White discloses printing images on paper using printer 61. Column 1 of White discusses printing the uncorrected red eye photographs, which can be achieved by White in box 218 of figure 11 by selecting no red eye correction, or by simply printing the red eye photograph without performing red eye correction. Printing the red eye corrected image can be achieved by White by performing the red eye correction process of figure 11 and printing the red eye corrected version of the image. Thus, a user who prints an image with printer 61 before using the red eye correction process, then prints an image with printer 61 after using the red eye correction process, would have the original and the red eye correction photographic prints of the image.

This rejection over White suffers from the same legal defect as discussed for claim 1. The

Examiner is citing from completely unrelated embodiments, which is contrary to Federal Circuit

precedent of *Net Money* and *Ex parte Beuther*. For claim 4, the rejection is even more defective because the citation is from a deficiency of the prior art to teach a concededly missing aspect of claim 4. The *KSR* case cited by the examiner does not excuse the Examiner from providing a rational supportable basis for a combination. Here, it is neither rational or supportable to cite a defect in the prior art to provide any kind of improvement to the disclosed embodiment. The rejection of claim 4 should be withdrawn.

White teaches printing the images one at a time. (See Fig. 11). White, however, does not teach or suggest photographic prints of both the corrected image, *and* the set of image and information or the original image. The Examiner's hypothetical operation of White simply does not support the rejection since it is speculative. A prior art rejection cannot be premised on unsupported assumptions or probabilities. *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Similarly, the rejection is again legally unsupportable by its premise on a hypothetical operation not taught or suggested. The mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modifications. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, White does not disclose or teach, "the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print" of the claimed invention.

**5. Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White in view of Shiota.**

**Claim 5**

Claim 5 recites, in part, “the image correcting section transmits the corrected image and image data together to the image recording section”. The Examiner asserts that the image handling apparatus 15 of Shiota discloses the image correcting section and image recording section, and that the image handling apparatus 15 transfers corrected image and image data as required in claim 5. Appellants disagree with the Examiner’s position

Appellants note that the Examiner has not responded to the patentability arguments regarding claim 5 set forth at pages 3 and 4 of the Amendment filed on July 21, 2008. Nevertheless, Shiota teaches the image handling apparatus 15 is a general purpose computer with dedicated software installed. (See col. 10, lines 53-55). The Examiner argues that a computer with the proper software programming and hardware discloses “the image correcting section” of the claimed invention. The Examiner’s reliance on FIG. 8, general purpose computer 15, however, is too general to teach the specific elements of claims 5. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together in Shiota as described in claim 5 of the present invention.

Furthermore, Shiota, only discloses transferring *processed* image data. (See col. 11, lines 1-5). The Examiner asserts in the Advisory Action dated August 22, 2008, that “If anything on [E]arth is obvious, it is transmitting both corrected image and image data. If a person of ordinary skill in this art

can do anything, he or she can transmit both the corrected image and the image data”. Appellants respectfully disagree with the Examiner’s position. Appellants respectfully submit that the Examiner has failed to offer any support in the Examiner’s obviousness rejection. Furthermore, Shiota fails to teach or suggest that the image handling apparatus 15 contains the proper software and hardware to “transmit *both* the corrected image and *image data*”. Accordingly, White and Shiota, alone or in combination fails to teach or suggest the features of claim 5.

**Claim 6**

For the same reasons that claim 5 is patentable over the prior art, claim 6 is also patentable over the prior art. Furthermore, Shiota does not overcome the deficiencies noted above in the teachings of White.

**6. Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White in view of Shiota.**

**Claims 7 and 8**

Claim 7 recites, in part:

the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data.

The Examiner asserts that, “printing the red eye corrected image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota” would have been obvious “for the benefit of increasing efficiency”. Appellants disagree with the Examiner’s position.

Appellants note that the Examiner has not responded to the patentability arguments regarding claims 7 and 8 set forth at pages 4 and 5 of the Amendment filed on July 21, 2008.

Specifically, the Examiner has not responded to Appellants' arguments that Shiota does not allow for the uncorrected data processes as described by claims 7 and 8, and that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine White and Shiota as suggested by the Examiner because there is no suggestion of motivation for doing so in the references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight.

Claims 7 and 8 describe alternative printing or data storage of corrected and original data. However, it is clear from FIG. 2, that all data stored or printed in Shiota is corrected data. Shiota discloses in FIG. 2 that all data stored or printed is processed data (corrected data). Alternatively, White teaches correcting for eye color defects but does not disclose storing an original image to external media. (See Abstract). The Examiner asserts that, "storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota" would have been obvious "for the benefit of increasing efficiency". However, FIG. 2 of Shiota teaches that all images stored in element 6 are processed data (corrected data). Thus, Shiota does not allow for the uncorrected data (original image) processes as described by claims 7 and 8. Because of the disparity between these two references, the only possible motivation for the Examiner's proposed combination is Applicant's own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

**7. Claim 9 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White.**

**Claim 9**

Claim 9 recites, in part, "an image correcting section that... transmits the corrected image data and original image data together to the image recording section". The Examiner

maintains that Shiota discloses transmitting the corrected image data and original data together in citing FIG. 1 and FIG. 8. Appellants disagree with the Examiner's position.

FIG. 2 of Shiota, shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together as described in claim 5 of the present invention, and Shiota does not disclose or suggest "transmits the corrected image data *and* original image data *together*" as recited in the claimed invention.

Claim 9 also recites, in part:

a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data.

The Examiner maintains that FIG. 1 and disk 6 of Shiota discloses the above recited features. Appellants disagree with the Examiner's position.

Shiota discloses that *the processed image* is stored on the recording medium 6. (See col. 11, lines 2-5). Shiota does not allow for the uncorrected data processes as described by claims 9. Thus, Shiota fails to teach or suggest an "image data *capable of reproducing the original image*", or "*the original image* onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data," as recited in the claimed invention.

**8. Claims 10-13 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White.**

**Claims 10 and 11**

Claim 10 recites in part, “image correcting section transmits the corrected image and image data simultaneously to the image recording section”. Claim 11 recites in part, “the image correcting section transmits the corrected image and image data sequentially to the image recording section”. The Examiner asserts that both claims 10 and 11 are disclosed in FIG. 8 of Shiota. Appellants disagree with the Examiner’s position.

FIG. 8 of Shiota shows a computer connected to a printer 5 and storage medium 6. Shiota, however, is silent on whether the data is transmitted together to the printer 5 and storage medium 6. (See col. 11, lines 1-5). But, FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted simultaneously or sequentially in Shiota as described in claims 10 and 11 of the present invention.

Appellants also submit that the Examiner has cited the same reference and elements in Shiota as anticipating both claims 10 and 11. Assuming *arguendo*, that Shiota does disclose transmitting the corrected image and image data together to the printer and storage medium, it would not follow that Shiota would also disclose both the simultaneous and sequential transmission of corrected image and image data. Thus, Appellants submit that the same Shiota reference and citations could not disclose both claims 10 and 11. At least one of claims 10 or 11 should be patentable.

**Claim 12**

For the same reasons that claim 7 is patentable over the prior art, claim 12 is also patentable over the prior art as claim 12 recites similar elements.

**Claim 13**

For the same reasons that claim 8 is patentable over the prior art, claim 13 is also patentable over the prior art as claim 13 recites similar elements.

**Conclusion**

Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Unless a check is attached, any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Theodore C. Shih  
Registration No. 60,645

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: January 22, 2009



**CLAIMS APPENDIX**

**CLAIMS 1-13 ON APPEAL:**

1. An image recording apparatus comprising:  
an image data input section that enters image data representative of an original image;  
an image correcting section that applies a predetermined correcting processing to the original image represented by the image data entered through the image data input section to create a corrected image; and  
an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in a form of either one of an image recording on a visual basis and a recording of image data, and records either one of a set of image and information capable of reproducing the original image and the original image onto a second external media for recording an image in form of either one of an image recording on a visual basis and a recording of image data.
2. An image recording apparatus according to claim 1, wherein the image correcting section applies a red-eye correcting processing to the original image.
3. An image recording apparatus according to claim 1, wherein the image data input section enters a photographic image, and

the image recording section records the corrected image into a photographic print, and records the set of image and information onto a medium for recording digital data.

4. An image recording apparatus according to claim 1, wherein the image data input section enters a photographic image, and

the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print.

5. An image recording apparatus according to claim 1, wherein the image correcting section transmits the corrected image and image data together to the image recording section.

6. An image recording apparatus according to claim 1, wherein the image correcting section transmits the corrected image and image data simultaneously to the image recording section.

7. An image recording apparatus according to claim 1, wherein the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data.

8. An image recording apparatus according to claim 1, wherein the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data.

9. An image recording apparatus comprising:  
an image data input section that enters original image data representative of an original image;

an image correcting section that applies a predetermined correcting processing to the original image data to create corrected image data, and transmits the corrected image data and original image data together to the image recording section; and

an image recording means for recording one of: a) a corrected image corresponding to the corrected image data subjected to the correcting processing and b) the corrected image data onto a first external media for recording one of: an image perceived on a visual basis and a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data.

10. An image recording apparatus according to claim 9, wherein the image correcting section transmits the corrected image and image data simultaneously to the image recording section.

11. An image recording apparatus according to claim 9, wherein the image correcting section transmits the corrected image and image data sequentially to the image recording section.

12. An image recording apparatus according to claim 9, wherein the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data.

13. An image recording apparatus according to claim 9, wherein the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data.

**EVIDENCE APPENDIX:**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellants in the appeal.

Appellants are not submitting any evidence.

**RELATED PROCEEDINGS APPENDIX**

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

There are no copies of decisions rendered by a court or the Board to be submitted.